

Restriction Requirement

In the Office Action mailed on August 25, 2005, the Examiner restricted the application to the following Groups of claims:

- I: Claims 1-11, drawn to an apparatus classified in class 604, subclass 275; and
- II: Claims 12-13, drawn to a method in class 128, subclass 898.

Election and Traverse

Applicant elects Group I, i.e., claims 1-11. This election is made *with traverse*.

The Office carefully makes the case that the claims of Groups I and II are *distinct*:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced with another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process (citation omitted). In this case the apparatus as claimed can be used as a garden hose connected with a reservoir for fertilizing grass. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

(Office Action, page 2). Thus, based on these assertions, the Office concludes by stating that because distinctiveness has been shown, restriction is proper. However, Applicant submits that restriction is not proper in this instance. M.P.E.P. § 803 states the requirement for a *proper* restriction.

There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed; and (B) **There must be a serious burden on the examiner if restriction is required.**

(M.P.E.P. § 803, citations omitted, emphasis added.) Thus, there are *two* requirements for restriction: distinctness *and* a serious burden on the Examiner. Both are required; distinctness without a serious burden is not sufficient to justify restriction. Indeed, section 803 explicitly states that “[i]f the search and examination of an entire application can be made without serious

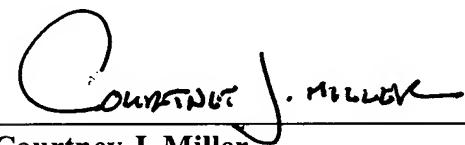
burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.”

Applicant respectfully submits that restriction is not proper in this case. While the claims of Groups I and II may satisfy the Office’s requirements for distinctness, their joint consideration would hardly result in a serious burden on the Examiner. The technology underlying both sets of claims is related, and thus a thorough prior art search conducted for one set of claims would certainly yield results useful for examination of the other set of claims. Thus, as stated, the Applicant asserts that restriction is improper.

If issues relating to this application can be resolved by discussion, the Examiner is invited to contact the undersigned attorney by telephone.

Respectfully submitted,

Date: September 26, 2005



Courtney J. Miller
Reg. No. 45,366
(614) 621-7015
(614) 621-0010 (fax)
cmiller@calfee.com